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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/796,025	03/10/2004	Wataru Tazoe	503.43626X00	2138
20457 7590 11/05/2009 ANTONELLI, TERRY, STOUT & KRAUS, LLP 1300 NORTH SEVENTEENTH STREET SUITE 1800 ARLINGTON, VA 22209-3873				
EXAMINER				
HAND, MELANIE JO				
ART UNIT		PAPER NUMBER		
3761				
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11/05/2009		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/796,025

Applicant(s)

TAZOE ET AL.

Examiner

MELANIE J. HAND

Art Unit

3761

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 August 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 25 and 28-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 25, 28-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)
- Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Arguments

1. Applicant's arguments with respect to the rejection of claim 25 under 35 U.S.C. 112 have been considered but are moot in view of the amendment to the claims.
2. Applicant's arguments with respect to the rejection of claim 25 under 35 U.S.C. 103 have been considered but are moot in view of the new ground(s) of rejection prompted by applicant's amendment to the claims.
3. Applicant's arguments with respect to the rejection of claim 28 under 35 U.S.C. 103 have been fully considered but they are not persuasive. Applicant argues that the urine receptacle of Conkling does not have as topsheet, absorbent material and outer sheet as claimed. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Lawrence already meets these limitations and Conkling was introduced to remedy the deficiency of the Lawrence reference with regard to a sensor, not the receptacle as a whole. Additionally applicant argues that there is no motivation to modify the Lawrence article to use a liquid sensor. It appears this position is based upon the argument addressed in this paragraph regarding the structure of the receptacle of Conkling. As that argument is not persuasive, the argument that there is no motivation to modify the Lawrence article so as to have the sensor of Conkling is without basis and also not persuasive.

Claim Rejections - 35 USC § 101

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 25, 29 and 30 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claim 25 recites a "wearer's urinating part and surrounding skin", neither of which are man-made. The claim must be amended to recite that the sheet is configured to be (or also, e.g., "adapted to") in contact with the urinating part and skin. Claims 29 and 30 depend from claim 25 and are thus rejected as well.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claim 30 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claim recites that the urine absorbent material is "mm thick". It is unclear what the precise scope of this claim is as it appears to be a typographical error and the entire range of "mm thick" is not supported by the disclosure as originally filed.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having

ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).
9. Claim 25 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lawrence et al (U.S. Patent No. 5,911,222) in view of Conkling et al (U.S. Patent No. 5,002,541) and further in view of Murai et al (U.S. Patent Application Publication No. 2002/0062114).

With respect to **claim 25**: Lawrence teaches an automatic urine disposal device comprising a urine receptacle 10 having an outer sheet 28 having a substantially rectangular shape and having a U-shaped cross-section (Fig. 2a) (Col. 5, lines 65-67), having a width at the middle portion in the longitudinal direction being narrow, so that it is shaped like an hourglass (Fig. 1), and having a gather provided along its periphery at cut out areas 15,16, formed from the backsheet 28, which is a liquid-impermeable and non-breathable thin sheet made of soft flexible materials, and accommodating a urine absorbent material 24 (Col. 6, lines 58-65) for storing urine; and a top sheet 21 formed as a liquid-permeable non-woven fabric, covering a top surface of said urine absorbent material 24 (Fig. 2a) with said outer sheet and keeping said urine absorbent material highly airtight as well as said outer sheet 28 (i.e. hard-breathable); a sealed urine tank 113 (Fig. 10); interface device 17 having an entrance zone for liquid entering through a porous membrane from absorbent material 24, said entrance zone with said porous

material considered herein to function as a drainage port. (Col. 6, lines 1-8); a urine drainage tube 110 for discharging urine through said urine drainage port from said urine absorbent material 24 to said urine tank 113, and made of soft flexible materials (as evidenced by Lawrence's teaching that said drain tube is capable of being hermetically sealed, i.e. it is deformable and thus flexible (Col. 6, lines 8-10); a vacuum pump 112 for decreasing air pressure in said urine tank 113; wherein urine is absorbed into said urine absorbent material 24 through a hole 20 on said top sheet upon wearer's urination, and said urine is discharged from said urine absorbent material 24 through said urine tube 110 to said urine tank 113.

Lawrence does not teach a urine sensor. Conkling teaches a urine collecting device 10 having a urine sensor 92 provided along urine drainage tube 96 and being electrically conductive in responsive to detecting urination in the vicinity of one end of a urine drainage port 94, said urine sensor 92 detecting wearer's urination and initiating vacuum pump 12. ('541, Col. 4, lines 35-63, Col. 5, lines 36-45) Conkling teaches that the sensor operates to activate a pump 12 for draining the urine from vessel 78, which would allow for increased storage area for incoming urine, therefore it would be obvious to one of ordinary skill in the art to modify the device of Lawrence so as to contain a urine sensor that activates the pump taught by Lawrence to drain said receptacle as taught by Conkling.

Lawrence does not disclose that a surface of the topsheet in contact with a wearer's urinating part and surrounding skin is a mesh sheet. Conkling also does not disclose a mesh material. Murai discloses an absorbent article with a portion of its outer surface that would contact a wearer's urinating part is constructed of a mesh material acting as a scale to accommodate and measure an amount of exudate. The mesh material of Murai is equally capable of acting as a liquid -permeable material in keeping with the objective and intended purpose of the topsheet of the Lawrence article. Thus, it would be obvious to one of ordinary

skill in the art to modify the article of Lawrence as modified by Conkling such that a surface of the topsheet in Lawrence with the wearer's urinating part and surrounding skin is a mesh sheet with a reasonable expectation of success to permit passage and retention of exudate as well as facilitating measurement of the capacity of the article when needed.

10. Claim 28 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lawrence et al (U.S. Patent No. 5,911,222) in view of Conkling et al (U.S. Patent No. 5,002,541).

With respect to **claim 28**: Lawrence teaches an automatic urine disposal device comprising a urine receptacle 10 having an outer sheet 28 having a substantially rectangular shape and having a U-shaped cross-section (Fig. 2a) (Col. 5, lines 65-67), having a width at the middle portion in the longitudinal direction being narrow, so that it is shaped like an hourglass (Fig. 1), and having a gather provided along its periphery at cut out areas 15,16, formed from the backsheet 28, which is a liquid-impermeable and non-breathable thin sheet made of soft flexible materials, and accommodating a urine absorbent material 24 (Col. 6, lines 58-65) for storing urine; and a top sheet 21 formed as a liquid-permeable non-woven fabric, covering a top surface of said urine absorbent material 24 (Fig. 2a) with said outer sheet and keeping said urine absorbent material highly airtight as well as said outer sheet 28, a sealed urine tank 113 (Fig. 10); interface device 17 having an entrance zone for liquid entering through a porous membrane from absorbent material 24, said entrance zone with said porous material considered herein to function as a drainage port. (Col. 6, lines 1-8); a urine drainage tube 110 for discharging urine through said urine drainage port from said urine absorbent material 24 to said urine tank 113, and made of soft flexible materials (as evidenced by Lawrence's teaching that said drain tube is capable of being hermetically sealed, i.e. it is deformable and thus flexible

(Col. 6, lines 8-10); a vacuum pump 112 for decreasing air pressure in said urine tank 113; wherein urine is absorbed into said urine absorbent material 24 through a hole 20 on said top sheet upon wearer's urination, and said urine is discharged from said urine absorbent material 24 through said urine tube 110 to said urine tank 113.

Lawrence does not teach a urine sensor. Conkling teaches a urine collecting device 10 having a urine sensor 92 provided along urine drainage tube 96 and being electrically conductive in responsive to detecting a urination in the vicinity of one end of a urine drainage port 94, said urine sensor 92 detecting wearer's urination and initiating vacuum pump 12. ('541, Col. 4, lines 35-63, Col. 5, lines 36-45) Conkling teaches that the sensor operates to activate a pump 12 for draining the urine from vessel 78, which would allow for increased storage area for incoming urine, therefore it would be obvious to one of ordinary skill in the art to modify the device of Lawrence so as to contain a urine sensor that activates the pump taught by Lawrence to drain said receptacle as taught by Conkling.

Conclusion

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MELANIE J. HAND whose telephone number is (571)272-6464. The examiner can normally be reached on Mon-Thurs 8:00-5:30, alternate Fridays 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tatyana Zalukaeva can be reached on 571-272-1115. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Melanie J Hand/
Primary Examiner, Art Unit 3761